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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/627,313

07/24/2003

Philip E. Eggers

A-03-4

1924

21394 7590 04/22/2008  
ARTHROCARE CORPORATION  
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EXAMINER

STIGELL, THEODORE J

ART UNIT

PAPER NUMBER

3763

NOTIFICATION DATE

DELIVERY MODE

04/22/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

intel\_prop@arthrocare.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/627,313	<b>Applicant(s)</b> EGGERS ET AL.	
	<b>Examiner</b> THEODORE J. STIGELL	<b>Art Unit</b> 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 54-70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 54-70 is/are rejected.
- 7) ☒ Claim(s) 55 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>See Continuation Sheet</u> .                                  | 6) <input type="checkbox"/> Other: _____                          |

Continuation of Attachment(s) 3). Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :1/18/2008,2/4/2005,2/4/2005,2/4/2005,2/4/2005,2/4/2005.

## **DETAILED ACTION**

### ***Response to Amendment***

#### ***Claim Objections***

Claim 55 is objected to because of the following informalities: The claim should be written with a "wherein" clause because the return electrode is already recited as part of the invention. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 54-56 and 59-70 rejected under 35 U.S.C. 103(a) as being unpatentable over Bales et al. (4,682,596). See Figure 3 and the respective portions of the specification. Bales et al. teach a surgical instrument for applying high-frequency electrical energy to tissue at a target site comprising a shaft (84), a hemispherical

shaped electrode terminal (86), an annular return electrode (90) spaced proximally from the hemispherical-shaped electrode, the return electrode having a surface area substantially larger than that of the electrode terminal, an electrically conductive fluid supply (deionized water), a connector (94,92) extending from the electrode terminal to the proximal end of the shaft and an electrically conducting electrode support (88) that can be made of either ceramic or glass (See Column 7, lines 10-16). Bales et al. also disclose a voltage supply configured to supply voltage to the electrode terminals. Bales et al. do not disclose the surface area of the tissue treatment surface. However, these parameters are deemed matters of design choice, well within the skill of the ordinary artisan, obtained through routine experimentation in determining optimum results.

Bales et al. also does not disclose to include an electrically conductive fluid wherein the electrical conductivity is at least 0.2 mS/cm, but because the Applicant has not stated in the instant specification that this particular conductivity works better than other electrical conductivity this limitation is also being treated as a matter of design choice. Therefore, the Applicant is merely claiming an electrically conductive fluid supply. The Examiner notes that Bales discloses using deionized water, which will have at least some electrical conductivity. Absent any evidence to the contrary, this will remain the Examiner's position.

Claims 57-58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bales et al. (4,682,596) in view of Herczog et al. (GB 2037167). Bales et al. teach all of the limitations of the claims except for explicitly reciting that the shaft has a bent configuration. Herczog et al. teach a bent configuration in the distal portion of the shaft.

It would have been obvious to one of ordinary skill in the a/t, at the time of invention, to modify the shaft of Bales et al. with the bent configuration taught by Herczog et al. for the well known purpose of providing for a transverse treatment location for structures parallel to the device.

### ***Response to Arguments***

Applicant's arguments filed 9/26/2007 have been fully considered but they are not persuasive. In response to the applicant's argument that Bales does not disclose a hemispherical shaped electrode terminal, the examiner respectfully disagrees. The examiner maintains that the electrode terminal (86) has a hemispherical shape. The examiner maintains that (86) looks to be half of a sphere, or at least a portion of (86) could be half of a sphere. The examiner also maintains that the limitation of a hemispherical geometry does not prevent the reference from having a hole through it.

In response to the applicant's argument that Bales does not disclose an electrically conductive fluid supply, the examiner respectfully disagrees. The applicant contends that deionized water is significantly less conductive than regular water or saline. However, even if this is so, it still doesn't prove that deionized water has no conductivity.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to THEODORE J. STIGELL whose telephone number is (571)272-8759. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nicholas Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Theodore J Stigell/  
Examiner, Art Unit 3763

/Nicholas D Lucchesi/  
Supervisory Patent Examiner, Art Unit 3763